



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,100	08/31/2001	Christopher E. McConn	086055-0103	3138

25734 7590 11/10/2005

FOLEY & LARDNER LLP
ONE MARITIME PLAZA
SIXTH FLOOR
SAN FRANCISCO, CA 94111

EXAMINER

GARCIA, GABRIEL I

ART UNIT	PAPER NUMBER
----------	--------------

2624

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/945,100

Applicant(s)

MCCONN ET AL.

Examiner

Gabriel I. Garcia

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/19/05 & 6/22/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Part III DETAILED ACTION

Claim Objections

1. Claim 13 is objected to because of the following informality: On line 6, the phrase "a integration" appears that it should be changed to "an integration".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 recites the limitation "**a file server*" in step (d). There is insufficient antecedent basis for this limitation in the claim. It is not clear whether the file server of step (c) is the same as file server of step (d). Clarification or correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

Art Unit: 2624

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 7-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kenyon (6,701,343).

With regard to claim 7, Kenyon teaches a method for enabling a plurality of service companies (e.g. community-n) to provide, on a network (see figs. 1-10), digital image processing (e.g. col. 2, lines 51-62, and col. 5, lines 55-58) and storage services (see item 10 of fig. 1) to customers of each service company, the method comprising: a) providing a database partitionable or indexable by service company (see fig. 1); b) receiving website feature set data from a service company and storing said data in a portion of said database partitioned or indexed for the service company (see fig. 1, col. 3, lines 54-65, and col. 7, lines 17-67); c) generating a website for each service company on the basis of the received website feature set data (col. 3, lines 54-65, and col. 7, lines 17-67); d) associating unique network addresses with each of said websites; e) receiving at least one digital image via one or more of said websites (e.g. col. 2, lines 51-62); and f) storing each received digital image in the portion of the database partitioned or indexed to the service company through whose website the digital image was received (e.g. col. 3, lines 54-65 and col. 7, lines 17-67).

With regard to claim 8, Kenyon further teaches providing a customer of a

Art Unit: 2624

service company with access to the portion of the database partitioned or indexed to the service company, wherein the service company thereafter the service to the customer (e.g. col. 3, lines 54-65).

With regard to claim 9, Kenyon further teaches wherein the digital image is received in step (f) is stored in a portion of the database further partitioned or indexed to the customer of the service company through whose website the digital image was received (e.g. col. 3, lines 54-65, and col. 7, lines 17-66).

With regard to claim 10, Kenyon further teaches wherein step (c) is performed by using the website feature-set data to complete a template (fig. 1-10, and col. 2, lines 51-62).

With regard to claim 11, Kenyon further teaches wherein the feature-set data include at least information relating to branding, a trademark, contact information, style schemes, privacy policies, a URL pointing to other related websites relating to the service company, prices for products or services, shipping options, fulfillment options and promotional material (see figs. 2-10).

With regard to claim 12, Kenyon further teaches transmitting an order placed by the customer to a destination pre-selected by the service company (e.g. col. 6, lines 3-25, which allow user(s) to send information to another destination).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

Art Unit: 2624

be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenyon (6,701,343) in view of Shiota et al. (6,324,521) .

With regard to claim 13, Kenyon teaches a network system for enabling a plurality of services companies, via a network, relating to digital image processing and storage to customers of each service company, the system comprising: a) a centralized processing system (14) configured to receive website feature set data from a service company and storing said data (see fig. 1, col. 3, lines 54-65, and col. 7, lines 17-67); b) an integration module (16) configured to generate a website for each service company on the basis of the received website feature-set data (see col. 3, lines 54-65, and col. 7, lines 17-67; e) a file server (10) configured to receive digital images via each service company's website to generate a websites to receive digital images via each service company's website (col. 3, lines 54-65, and col. 7, lines 17-67); and, d) a file server configured to store said digital images in a database partitioned or indexed to the service company through whose website the image was received, wherein the central processing system is further configured to associate a unique network address with the website generated for each service company (e.g. col. 2, lines 39-63, col. 3, lines 54-65, and col. 7, lines 17-67). Kenyon does not teach the service companies being a plurality of photolabs. However, Shiota et al. teaches that it is well known in the art at the time of the invention to have a

Art Unit: 2624

plurality of photolabs connected in a network to process photos (see figs. 1-8).

Therefore, it would have been obvious to one of ordinary skill at the time of the invention to exchange the community websites of Kenyon with the plurality of photolabs as taught by Shiota et al because of the following reason: a) will allow the websites generation of Kenyon to be implemented in a system using photolabs allowing the system of Kenyon to process print jobs in different location as suggested by Shiota in col. 2, lines 1-9.

With regard to claim 14, Kenyon further teaches the central processing system is further configured to provide a customer of a service company with access to the portion of the database partitioned or indexed to the customer of the service company, wherein the service company thereafter provides the service to the customer (e.g. col. 3, lines 54-65, and col. 7, lines 17-66).

With regard to claim 15, Kenyon further teaches wherein the database is further partitioned or indexed to the customer of the service company through whose website the digital image was received, for storage of the digital image is portion of the database partitioned or indexed to the customer (e.g. col. 2, lines 39-63, col. 3, lines 54-65, and col. 7, lines 17-67).

With regard to claim 16, Kenyon further teaches wherein the integration module is configured to generate the website by using received website feature-set data to complete a template (e.g, claims 2 and 8).

With regard to claim 17, Kenyon further teaches wherein the integration module is further configured to populate the service company's website with website feature-set data including information relating to branding, a trademark,

Art Unit: 2624

contact information, style schemes, privacy policies, a URL pointing to other related websites relating to the service company, prices for products or services, shipping options, fulfillment options and promotional material (see figs. 2-10).

With regard to claim 18, Kenyon further teaches wherein the central processing is further configured to transmit an order placed by the customer to a destination pre-selected by the service company (e.g. col. 6, lines 3-25, which allow user(s) to send information to another destination).

Conclusion

5. Applicant's arguments with respect to claims 7-18 have been considered but are moot in view of the new ground(s) of rejection necessitated by applicant's amendments filed on 6/22/05 and 8/19/05.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory

Art Unit: 2624

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (571) 272-7434. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is (703) 872-9314.

On July 15, 2005, the Central FAX Number will change to 571-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

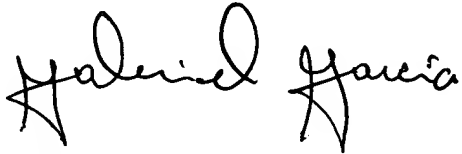
Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

Art Unit: 2624

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2600.

**GABRIEL GARCIA
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Gabriel Garcia". The signature is fluid and cursive, with the first name "Gabriel" and the last name "Garcia" clearly distinguishable.

**Gabriel I. Garcia
Primary Examiner
November 8, 2005**